

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Bellofatto	
Application No.: 10/696,963	Art Unit: 3728
Filed: 10/30/2003	Examiner: Mohandesi, Jila M
Title: PADFOLIO WITH TAPERED ELASTIC OUTER POCKET	
Attorney Docket No.: 059863/0040	

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Honorable Assistant Commissioner for Patents
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APPEAL BRIEF UNDER 37 CFR 41.37

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REAL PARTY IN INTEREST

The real party in interest is The Gem Group, Inc. d/b/a GEMLINE, the assignee of record.

RELATED APPEALS AND INTERFERENCES

None.

STATUS OF CLAIMS

Claims 1-20 have been cancelled.

Claims 21-25 are currently pending, as they have been rejected to. Claims 21-25 are being appealed.

STATUS OF AMENDMENTS

Amendment after final action under 37 CFR 1.116

Amendment filed January 12, 2007 containing amended claims presented in better form for consideration on appeal under 37 CFR §1.116(b)(2), filed with the notice of appeal. The amendment, as indicated in the Office communication mailed February 6, 2007, fails to place the application in condition for allowance. However, the amendment did overcome the 35 USC 112, second paragraph rejection.

For purposes of appeal, the proposed amendments (to the claims) will be entered. Claims 21-25 are currently pending.

SUMMARY OF CLAIMED SUBJECT MATTER

Claim 21

Claim 21 claims a padfolio (see FIG. 1 or 2) comprising: a pair of opposing covers **104**, **202** (see FIG. 2) joined together by a spine **108**; an exterior pocket **102** formed by a flap **140** joined along a base edge **160**; the flap including a front edge **164** and two side edges **162**, each side edge having a recess taper; and a pair of elastic strips **170**.

The exterior pocket **102** is illustrated in FIG. 1 and is explained on page 3, lines 3-4. The exterior pocket **102** is along an exterior face cover **132**, as explained on page 3, lines 3-4. This exterior cover **104** is joined by a spine **108** to an opposing exterior cover **202** (see page 3, lines 4-6). The materials and characteristics of the joints between the sections of the padfolio are described in further detail on page 3, in lines 6-8. The materials used for the padfolio itself, including the covers **104** and **202** is explained in further detail on page 3 in lines 8-14.

The exterior pocket **102** is formed by a flap **140** that is described in greater detail in the specification, page 4 line 9 – page 5 line 2. Materials and alternative approaches used to construct the flap **140** are described in detail on page 4, lines 9-18. The base of the flap **140** is fixedly attached to the spine **108** at a bottom or base seam edge **160** (see page 4 lines 19-22). The flap **140** includes a front edge **164** and two side edges **162** (see page 4 lines 21-24). These side edges **162** extend at a gap from the bottom edge **160** to provide a taper toward the front edge **164**. See page 4 lines 24-28 and page 5 lines 18-23 for more detail on the taper of the flap **140**.

The padfolio further comprises a pair of elastic strips **170** connected between each side edge **162** and the exterior surface **132**. In this manner, the front edge **164** and the two side edges

162 are unattached to the cover **104, 202**, except by the pair of elastic strips **170**. The elastic strips **170** are described in greater detail on page 5, lines 5-17, 24-30 and page 6, lines 1-10.

Claim 22

Claim 22 claims a padfolio (see FIG. 1 or 2) comprising: a flap **140** attached adjacent to a spine **108** where the flap creates a base edge **160**, two side edges **162** and a front edge **164**, the front edge **164** being unattached to the exterior cover **132**; an outer perimeter edge **130** stitched on the exterior cover **132**; the two side edges **162** being unattached except by a pair of elastic strips **170** and including a taper defined as a gap (see page 5 lines 18-23).

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

Whether claims 21-24 are unpatentable under 35 USC 102 as being anticipated by Seamon.

Whether claims 21-25 are unpatentable under 35 USC 103 over Seamon.

ARGUMENT

Rejection under 35 USC 102(b) over Seamon

Claims 21 and 22

Claims 21 and 22 (as well as 23 and 24, not argued separately here) were rejected by the Examiner under 35 USC 102(b) as being anticipated by Seamon (Pub. No. US 2002/0121322). For a reference to anticipate a claim(s), each and every element set forth in the claim(s) must be found, either inherently, or expressly described, in a single prior art reference. Applicant respectfully asserts that the Seamon reference does not anticipate the applicant's claimed invention, in particular with reference to the independent claims 21 and 22. Please note for the record that the Office Action referred to hereinafter, unless otherwise stated, is the Office Action mailed on October 13, 2006.

Each and every element set forth in the applicant's claims is not described in the Seamon reference. The examiner sets forth the elements of the applicant's claims that the examiner claims to be described in the Seamon reference in paragraph 5 beginning on page 2.

Front edge of flap is unjoined/unattached

The first element that the Seamon reference fails to describe, either inherently or expressly, is that the front edge of the flap is "un-joined to the exterior surface and thereby capable to receive documents through the front edge". The specific claim language that provides for this limitation is found in claim 21 as "unjoined to the exterior surface and thereby constructed and arranged to receive documents through the front edge" and in claim 22 as "unattached to the exterior cover, and the front edge being adapted to allow documents to slide into the pocket through the front edge".

The examiner, on page 3 of the Office Action, argues that the Seamon reference describes the limitation of having a front edge that is “unjoined to the exterior” because it “can be maintained in its un-extended position without a *closure*”. However, this is described in paragraph 0010 of the Seamon reference and states that the pocket can be closeable and opened or that it can be an open pocket having no closures. For the purposes of the description the “closure” is zipper 13. The fact that the specification recites the pocket may be openable and closeable or in an open position implies that in the open position, the pocket is not closeable and therefore cannot perform the intended use of receiving and retaining documents as described and claimed by the applicant. For the Seamon reference to perform the same function as applicant’s claimed invention (of receiving documents through an unattached or unjoined front edge) it would have to be in this “open pocket” embodiment which would not anticipate applicant’s claimed invention because it would not be capable of tensioning documents in the pocket as claimed and described by applicant and explained in greater detail below.

In paragraph 9 on page 5 of the Office Action, the examiner states that “a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the invention ... if the prior art structure is capable of performing the intended use, then it meets the claim.” However, the intended use (of receiving and retaining documents through an unattached or unjoined front edge **does result** in a structural difference between applicant’s claimed invention and the Seamon reference. For the Seamon reference to be able to perform the intended use of receiving and **retaining** documents, it would have to employ the zipper 13, or another “closure”, and would therefore not anticipate applicant’s claimed invention because it would be **attached**.

Elastic strips

There is yet another element of applicant's claimed invention that is not described in the Seamon reference: the elastic strips. On page 3 of the Office Action, the examiner stated that the Seamon reference discloses a pair of elastic strips (straps 14 of the Seamon reference). Applicant respectfully disagrees with the examiner.

The examiner states that because the "webbing" 14 of the Seamon reference can be stretched and then go back to its original length and shape implies that it is elastic. However, this is not the case and there is no teaching or suggestion of any "elastic" stretch or structure in Seamon. To ascribe such a structure or function can only occur based upon improper hindsight reasoning, as the examiner is attempting to read the applicant's claimed invention into the Seamon reference.

More particularly, the examiner states that the straps 14 can be stretched, as illustrated in Figs. 2-4 of the Seamon reference, and then the webbing can "go back to its original length and shape as shown in Fig. 1". However, to presume that applicant's key feature of elasticity is provided in Seamon is far too speculative, and is *nowhere* described in the Seamon reference. It is not clear whether the straps 14 do in fact go back to their original length and shape in Fig. 1, which merely illustrates the straps 14 contained within the pocket 11, but there is **no mention** of the state or structure of these straps. It is almost impossible to infer from the Seamon reference that the straps go back to their original length and shape, as it is nowhere illustrated or described in the Seamon reference. Therefore, it is only through improper hindsight reasoning that the examiner has concluded that the straps 14 of the Seamon reference are elastic. There is no mention of using elastic for the straps and the straps are specifically described in paragraph 0010:

“The pocket 11 swings out from the surface of the pouch 10 at an angle of less than 90 degrees, and is *held back from full extension by straps 14*.” This clearly describes that the straps are intended to **prevent** the pocket from full extension, and there is no teaching or suggestion *whatsoever* that the straps 14 of the Seamon reference are used for or capable of performing any other function, such as forcible elastic retraction of the inner pocket 11 of the Seamon reference. To wit, the presence of a zipped closure in the Seamon reference suggests that retraction and closure is provided by this zipper rather than the limit straps.

Tensioning of the elastic strips

Furthermore, the applicant not only claims a pair of elastic strips, which the Seamon reference does not contemplate, but the elastic strips also apply “continuous tension to hold the flap (140) closely against the stack top” (see page 6 of the specification, lines 9-10), which the Seamon reference clearly does not teach or suggest. The claim language is found in claim 21 as “the elastic strips generating tension and constructed and arranged to maintain a holding friction against the documents” and claim 22 as “the flap is tensioned against the exterior cover by the elastic strips”

In fact, because there is no suggestion that the straps 14 of the Seamon reference are elastic, it is nearly impossible for the straps 14 to “generate tension” in the manner as claimed and described by the applicant. In fact, the elastic straps 14 are described in the Seamon reference as preventing the pocket from full extension, not for providing tension. Tension is not even suggested and is contrary to the purpose of the straps 14 of Seamon reference (to prevent full extension of the pouch so that contents will not fall out).

It is believed that the Seamon reference does not anticipate applicant's claimed invention, in particular independent claims 21 and 22. Therefore any anticipation rejections to claims depending therefrom should now be addressed.

Rejection under 35 USC 103(a) over Seamon

Claims 21 and 22

Claims 21 and 22 (as well as 23, 24 and 25, not argued separately here) were rejected under 35 USC 103(a) as being obvious over Seamon. Applicant respectfully traverses this rejection. The examiner argues that the tapered gap between the outer perimeter edge and the side edge would have been obvious to one of ordinary skill in the art. However, examiner argues that this merely involves a change in the shape of a component. The examiner relies on *In re Dailey* for the proposition that a change in shape is generally recognized as being within the level of ordinary skill in the art. However, *In re Dailey* related to a disposable nursing container for infants, and the applicant's claims were rejected because they "presented no argument which convinced the court that the particular configuration of their inventions was significant or anything more than one of numerous configurations a person of ordinary skill in the art would have found obvious."¹

However, the novel shape provided by applicant in his claimed invention is a functional change and not an arbitrary change purely for aesthetic purposes. The examiner stated, as previously mentioned above, that an intended use must result in a structural difference. Another intended use of the claimed invention is to partially reveal whether there are documents retained

¹ *In re Donald E. Dailey and Anton F. Eilers*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966).

within the padfolio. This is in claim 21 as “each side edge having a recess taper to partially reveal whether at least a single document is held within the pocket while the flap is tensioned against the exterior surface” and in claim 22 as “the taper partially revealing at least a single document within the pocket when the flap is tensioned against the exterior cover by the elastic straps”.

The taper of the applicant’s claimed invention, thus, is not obvious over the Seamon reference. The examiner has shown no basis for a determination of obviousness and has not provided the necessary reference for teaching or suggesting *why* the taper is obvious. The taper is the only element addressed by the examiner for obviousness, and given the above arguments, the other elements have been shown to be absent in the Seamon reference.

It is believed that the applicant’s claimed invention, in particular claims 21 and 22, are not obvious in view of the Seamon reference. Accordingly, any rejections to claims depending therefrom should now be addressed, and the claims as presented should be allowable. Applicant, therefore, respectfully requests a finding of allowability and issuance of a Notice of Allowance by the examiner.

CLAIMS APPENDIX

- 1 21. A padfolio having an exterior pocket along an exterior cover comprising:
2 a pair of opposing covers joined together by a spine on an edge of each of the
3 opposing covers;
4 the exterior pocket being located on an exterior surface of one of the opposing
5 covers, wherein the pocket is formed by a flap joined along a base edge, the base edge
6 being joined the exterior surface adjacent to the spine;
7 the flap including a front edge unjoined to the exterior surface and thereby
8 constructed and arranged to receive documents through the front edge, the flap further
9 including two side edges, each side edge having a recess taper to partially reveal whether
10 at least a single document is held within the pocket while the flap is tensioned against the
11 exterior surface; and
12 a pair of elastic strips connected between each side edge, respectively, and the
13 exterior surface, the elastic strips generating tension and being constructed and arranged
14 to maintain a holding friction against the documents, and the front edge and the two side
15 edges being unattached to the cover except by the pair of elastic strips while a region in
16 which documents may be viewed is visible along the side edges remote from the straps.
- 1 22. A padfolio with an exterior pocket along an exterior cover comprising:
2 a flap attached adjacent to a spine of the padfolio, where the flap creates a base
3 edge adjacent to the spine, two side edges, and a front edge;

4 the front edge unattached to the exterior cover, and the front edge being adapted to
5 allow documents to slide into the pocket through the front edge;
6 an outer perimeter edge stitched on the exterior cover in an approximately
7 rectangular shape with one side adjacent to the base edge and the approximately
8 rectangular shape being slightly larger than the flap; and
9 the two side edges being unattached except by a pair of elastic strips attached
10 between plies of the flap and the outer perimeter edge, and the two side edges including a
11 taper defined as a gap between the outer perimeter edge and the side edge being narrower
12 at the base edge and wider at the front edge, the taper partially revealing at least a single
13 document within the pocket when the flap is tensioned against the exterior cover by the
14 elastic straps.

1 23. The padfolio of claim 22, wherein the elastic strips being configured with a width
2 less than half a length of the side edge.

1 24. The padfolio of claim 22, wherein the gap being configured by a width of the base
2 edge being greater than a width of the front edge.

1 25. The padfolio of claim 24, wherein the gap being generated by an angle between
2 approximately 2 and 5 degrees.

EVIDENCE APPENDIX

None.

RELATED PROCEEDINGS APPENDIX

None.

Should any unresolved issues remain, it is respectfully requested that the Examiner telephone the undersigned attorney for applicant at 603-225-4334 so that such issues may be resolved as expeditiously as possible.

Please charge any fee or fee deficiency that is otherwise unpaid to Deposit Account Number 502834.

Respectfully Submitted,

A handwritten signature in black ink, appearing to read 'W. Loginov', is written over a horizontal line.

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